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09/856,178	06/04/2001	Hiromu Ueshima	100341-00009	9626

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/856,178

Applicant(s)

UESHIMA ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## ***DETAILED ACTION***

### ***Claim Objections***

The objection to claim 9 is withdrawn.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The feature of a second housing is not shown. *See claims 1 and 7.* Figure 3 illustrates a solid, double line denoting a single housing encompassing the entire device. The examiner notes that the specification refers to a "reel housing". *See p. 6, lines 8-13.* However, this term is merely descriptive. As illustrated in figure 3(50), "reel housing" describes the lower portion device's single housing (30), not a separate and distinct housing. Thus, the feature of a second housing must be shown or the canceled from the claims. No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Amended claims 1 and 7 describe a casting rod having a first housing and a second housing. However, the specification discloses

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only a single housing. *See p. 4, lines 8-10.* Figure 3 illustrates a solid, double line denotes a single, physical structure encompassing the entire device. The examiner notes that the specification refers to a “reel housing”. *See p. 6, lines 8-13.* However, this term is merely descriptive. As illustrated in figure 3(50), “reel housing” describes the lower portion device’s single, physical housing (30). Thus, the feature of a second housing was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 2-6 and 8-14 inherit this deficiency from claims 1 and 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 3-6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tosaki et al., U.S. Patent 6,312,335 B1 (Nov. 6, 2001) in view of Uemura et al., U.S. Patent 4,521,020 (Jun. 4, 1985) and Clemmer et al., U.S. Des. 428,937 (Aug. 1, 2000)**

*Tosaki* discloses a fishing game system wherein the input device is a simulated fishing rod and reel. The input device includes means for detecting physical movement of the device as a whole and converting the physical quantities to a detection signal that is output to the game process. *See abstract.* The input device further includes vibration means for inducing mechanical displacement corresponding to instruction signals. *See id.*

Claims 1 and 7. *Tosaki* teaches the features of the claims listed below:

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- a. Casting rod having a housing. *See fig. 1; col. 2:50-51.*
- b. A reel handle attached to the casting rod as to be freely rotated. *See fig. 1(17).*
- c. Acceleration sensor provided in the casting rod to output an accelerant signal during casting. *See fig. 5; col. 2:1-16, 7:4-60.*
- d. A rotation amount associated signal generation means interactive with the reel handle for outputting a rotation amount associated with the ration of the handle. *See fig. 2a(24-26)), 2b.*
- e. A game processor. *See fig. 1(2), 4(2).*
- f. A memory device for storing program information and image data which are read by the game processor. *See fig. 1(2a), 4(2).*
- g. Game processor includes input means for receiving an acceleration signal and a second input means for receiving an rotation signal. *See fig. 4.*
- h. Means in the casting rod for determining the casting distance on the game screen based on the acceleration signal. *See fig. 1, 5; col. 10:28-11:61.*
- i. Means for producing a game screen according to the calculated distance by reading-out the image data in correspondence to the casting operation from said memory. *See fig. 5, 6.*
- j. Means for calculating a reeling length in accordance with information applied from the rotation signal means. *See id.*
- k. Means for determining the reeling operation based on the casting distance and reeling length. *See id.*

*Tosaki* does not describe a game processor and memory within the housing of the casting rod. In addition, *Tosaki* does not describe the casting rod having a first housing and a second housing.

Regardless, as discussed below, these feature would have been obvious to an artisan.

First, integrating a game processor and memory within the housing of the casting rod would have been obvious to an artisan in view of *Uemura*. It is generally within the ordinary skill of an artisan to use

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one piece construction instead of the structure disclosed in the prior art. *See In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). In this case, *Uemura* discloses a gaming system wherein the player-controls, processing and input/output are housed within the housing of a controller that connects directly to a television. *See fig. 1; col. 4:46-50, col. 6:5-45*. In view of *Uemura*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the game system disclosed by *Tosaki* to add the feature of having the game processor and input device within the same housing. As suggested by *Uemura*, the modification would enhance the game system by providing a simpler structure and reducing cost. *See fig. 1; col. 4:46-50, col. 6:5-45*.

Second, separating the components of the casting rod between a first housing and a second housing would have been obvious to an artisan. *Clemmer* discloses an analogous casting rod for a fishing game wherein the casting rod has a first housing and a second housing. *See fig. 1-6*. As illustrated, the two housings provide a realistic representation of a casting reel attached to an fishing rod. *See id.* In view of *Clemmer*, it would have been obvious to an artisan at the time of the invention to modify the fishing rod disclosed by *Tosaki*, wherein the rod and reel are combined within a single housing, to add the feature of a first housing and a second housing. As shown by *Clemmer*, the modification would enhance the game by providing a more realistic representation of a casting reel attached to an fishing rod and thereby make the system more appealing to consumers. Moreover, it would have been an obvious design choice to place the acceleration sensor to place it within the lower housing.

Consequently, for the reasons given above, when the prior art is taken as a whole, it would have been obvious to an artisan to modify the fishing game system disclosed by *Tosaki*, to integrate the game processor and memory within the housing of the casting rod wherein the casting rod is comprised of a first housing and a second housing.

Claim 3. The fishing game system suggested by the combination of *Tosaki* with *Uemura* and *Clemmer* describes all the features of the claim except the acceleration sensor including a piezoelectric buzzer element generating an electrical signal correlated to acceleration. In particular, *Tosaki* describes a casting rod incorporating sensors to detect the magnitude of the rod's acceleration during casting and thereby determine the strength of the user's input. *See col. 10:58-11:22*. It is known in the art to employ piezoelectric buzzer elements to generate electrical signals corresponding to acceleration. Thus, in this case it would have been obvious to an artisan at the time of the invention to modify the fishing game system suggested by the combination of *Tosaki* with *Uemura* to employ piezoelectric buzzer elements to generate electrical signals corresponding to acceleration during casting.

Claim 4. *Uemura* additionally teaches an AV cable connecting the game system with the television monitor to supply video and audio signals from the game processor to the television through the AV cable. *See fig. 1(21); col. 6:5-30; 12:54-13:12*.

Claim 5. *Uemura* additionally teaches a game system including an information storage medium and a game processor including operation processing means, image processing means and memory. *See fig. 2-20*.

Claim 6. *Tosaki* additionally teaches an information storage medium including a non-volatile semiconductor memory. *See col. 4:43-54*.

**Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tosaki* in view of *Uemura* and *Clemmer*, as applied to claim 1 and 7 above, in further view of Goschy et al., U.S. Patent 6,545,661 B1 (Apr. 8, 2003).**

The fishing game system suggested by the combination of *Tosaki* in view of *Uemura* and *Clemmer* describes all the features of the instant claims except a light spot detecting means for detecting a light spot of a scanning display and determining the direction of the cast on the game screen according to the output of the light spot detecting means.

*Goschy* discloses an analogous apparatus for controlling a video game wherein the game is controlled in response to the output of an accelerometer and light spot sensor. *See col. 1:55-2:9*. The system includes a game controller, a video display and a hand-held control unit. *See id.* The control unit houses an accelerometer that senses the tilt of the control unit with respect to an axis. *See id.* The accelerometer produces an acceleration signal indicating the tilt of the control unit with respect to the axis. The game controller processes the acceleration signal to control the movement of a game character on the video display. *See id.* Additionally, the control unit includes a light sensor that detects one or more light pixels from the video display and produces a detection signal to the game controller. *See id.* The game controller determines from the detection signal the light pixels detected from the video display. *See id.* *Goschy* teaches the system enhances the game by allowing a player to input direction commands by tilting the controller and then select a target merely by pressing a button. *See col. 1:46-52*. The reference suggests the system is particularly well suited for video games where guns, swords, bats, clubs, rackets, gloves, etc. are used to manipulate characters on a video display. *See col. 2:5-8*. Hence, *Goschy* generally suggests employing the system in games where the controller is swung.

In view of *Goschy*, it would have been obvious to an artisan at the time of the invention to modify the fishing game apparatus suggested by the combination of *Tosaki* in view of *Uemura* and *Clemmer*, wherein a simulated casting rod is swung at a screen, to add the feature of a light spot detecting means for detecting a light spot of a scanning display and determining the direction of the cast on the game screen according to the output of the light spot detecting means. As suggested by *Goschy*, the modification would enhance a video game where a controller is swung to control the game by allowing a player to



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input direction commands by tilting the controller and then select a target merely by pressing a button.

*See col. 1:46-52.*

Claim 10: The fishing game system suggested by the combination of *Tosaki* in view of *Uemura*, *Clemmmer* and *Goschy* describes all the features of the instant claim except the acceleration sensor including a piezoelectric buzzer element and signal output means from outputting an acceleration signal correlated to the buzzer. Regardless, acceleration sensors having piezoelectric buzzers are well known and commercially available. It would have been obvious to an artisan at the time of the invention to modify the fishing game system suggested by the combination of *Tosaki* in view of *Uemura*, *Clemmmer* and *Goschy*, wherein an accelerometer is employed to measure the movement of a simulated fishing rod, to employ an accelerometer including a piezoelectric buzzer element wherein the signal output from the buzzer correlates to an acceleration signal because the modification is a substitutable equivalent known for the same purpose of measuring acceleration.

Claim 11: *Tosaki* additionally describes a rotation amount associated signal generating means generates numbers of pulse signals and the second input means includes a mouse-type counter that counts the pulse signals. *See fig. 2a(26), 2b(101); 6:61-7:3.*

Claim 12: *Tosaki* additionally teaches the casting rod includes a vibrator that is driven by the game processor when a fish bite occurs in the process of the game. *See col. 3:66-4:6.*

Claims 9 and 13. *Tosaki* additionally teaches a tension key operated by a game player to control the tension on the fishing line displayed on the screen and the game processor determining that the game player fails to catch a fish when the tension reaches a predetermined value. *See col. 14:59-15:25.*

Claim 14. *Tosaki* additionally teaches the rotation amount associated with the signal generating means generates the rotation signal as a number of pulse signals and the second input means includes a mouse input which counts the pulse signals. *See fig. 2a(24-26), 2b, 4(24, 104), 6(S22,S25).*

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

In response to the applicants assertion that conclusion of obviousness is based upon improper hindsight. The examiner respectfully disagrees. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *See In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case, *Tosaki* discloses a fishing game system wherein the input device is a simulated casting rod. The rod includes means for detecting physical movement of the device and converting the physical quantities to a detection signal that is output to the game process. *See abstract*. A game processor for determining casting distance is provided external to the simulated fishing rod. *See fig. 1(2)*. *Tosaki* teaches all the features of the claimed invention except having a game processor located in the

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housing of the casting rod. *Uemura* discloses an analogous gaming system wherein the player-controls images on a CRT through a handheld controller containing a game processor. *See fig. 1; col. 4:46-50, col. 6:5-45*. The reference discloses that multipurpose gaming systems, such as *Tosaki*, are expensive and complicated because they require a employing a computer, . *See col. 2:28-61*. To overcome these disadvantages, *Uemura* suggests combining the components into a single unit having simpler structure and reduced cost. *See col. 4:12-20*. When taken as a whole, the prior art suggests to an artisan at the time of the invention a fishing game system having a simulated casting rod wherein the game processor and memory is located in the housing of the casting rod.

Consequently, the applicant's argument of impermissible highlight is unpersuasive because the suggested to modify the references was found in the prior art and not within the applicant's disclosure.

Furthermore, the applicant's argument that *Tosaki* teaches away from the combination with *Uemura*. The examiner respectfully disagrees. The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). The references must be considered as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In this case, *Tosaki* describes fishing game having a processor external to a casting rod. There is no statement in *Tosaki* stating the processor should be placed externally. The mere fact that *Tosaki* describes an external processor does not outweigh the explicit teaching of *Uemura* that a system having an external processor may be modified to incorporate the system in a single unit to produce simpler structure and reduced cost. *See col. 4:12-20*. Hence the examiner maintains that the prior art, when taken

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as a whole by an artisan collectively suggest a fishing game system having a simulated casting rod wherein the game processor and memory is located in the housing of the casting rod. *See supra.*

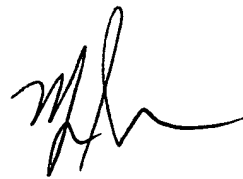
Consequently, for all the reasons given above, the rejection is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER  
PRIMARY EXAMINER